

### REMARKS

Claims 1-15 are pending in the present application. Claims 1-7 are amended. Claims 8-15 are added. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 102, Anticipation**

The Office Action rejects claims 1-7 under 35 U.S.C. § 102 as being anticipated by Toumbas (US Patent No. 5,940,356). This rejection is respectfully traversed.

As to claims 1-7, the Office Action states:

Toumbas '356 discloses a method for expanding a storage library having media players and horizontally moving robots per claimed invention. The method comprises increasing the library in all three dimensions by increasing the width, length, and vertical dimension of the horizontal storage cell array (Figures 1-64).

Office Action, dated July 18, 2003. Applicant respectfully disagrees. Toumbas teaches a modular compact disk filing system with automatic disk selection and playing.

According to the disclosure of Toumbas, the system can be expanded by adding an infinite number of three basic structural unit modules in all three dimensions and updating the system information files. See Abstract.

In contradiction, the present invention provides a method for providing a scalable library that includes a plurality of horizontal storage cell arrays. Claim 1, as amended, recites:

1. A method for providing a scalable storage library, the method comprising:
  - providing a storage library comprising a plurality of horizontal storage cell arrays, wherein each horizontal storage cell array is comprised of storage cells arranged in a horizontal plane of rows and columns;
  - providing at least one media cartridge player; and
  - providing at least one robot mechanism that moves along a horizontal storage cell array and can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells.

Toumbas does not teach or fairly suggest providing a storage library comprising a **plurality of horizontal storage cell arrays**, as recited in claim 1. The media in Toumbas is compact disks, which are not stored in horizontal storage cell arrays.

Furthermore, Toumbas fails to teach or suggest "at least one robot mechanism that moves along a horizontal storage cell array and can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells," as recited in claim 1. Since the applied reference fails to teach each and every claim limitation, claim 1 is not anticipated by Toumbas. New claim 10 recites subject matter addressed above with respect to claim 1 and is allowable for the same reasons.

Since claims 2-9 and 11-15 depend from claims 1 and 10, the same distinctions between Toumbas and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-9 and 11-15 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-7 is overcome.

The Office Action rejects claims 1-5 and 7 under 35 U.S.C. § 102 as being anticipated by Tadokoro et al. (US Patent No. 6,166,877). This rejection is respectfully traversed.

As to claims 1-5 and 7, the Office Action states:

Tadokoro '877 discloses a method for expanding a storage library having media players and horizontally moving robots per claimed invention. The method comprises increasing the library size by increasing the width and length dimensions of the horizontal storage cell array (Figures 13-19).

Office Action, dated July 18, 2003. Applicant respectfully disagrees. Tadokoro teaches a cassette auto changer system. Tadokoro teaches that the cassette auto changer includes a base console including a port for tape insertion or extraction operations and having a tape insert compartment. A drive console mounts the tape signal reading member and a cassette console mounts a plurality of compartments for storing the tape cassettes. A tape transfer member transports the tape cassettes selectively between the base console, the drive console, and the cassette console. See Abstract.

Tadokoro does not teach or fairly suggest providing a storage library comprising a **plurality of horizontal storage cell arrays**, as recited in claim 1. Tadokoro is an example of vertical tape storage. Furthermore, Tadokoro fails to teach or suggest "at least one robot mechanism that moves along a horizontal storage cell array and can

dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells,” as recited in claim 1. Since the applied reference fails to teach each and every claim limitation, claim 1 is not anticipated by Tadokoro. New claim 10 recites subject matter addressed above with respect to claim 1 and is allowable for the same reasons.

Since claims 2-5, 7-9, and 11-15 depend from claims 1 and 10, the same distinctions between Tadokoro and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-5, 7-9, and 11-15 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-5 and 7 is overcome.

The Office Action rejects claims 1-7 under 35 U.S.C. § 102 as being anticipated by Dang et al. (US Patent No. 5,663,938). This rejection is respectfully traversed.

As to claims 1-7, the Office Action states:

Dang '938 discloses a method for expanding a storage library having media players and horizontally moving robots per claimed invention. The method comprises increasing the library in all three dimensions by increasing the width, length, and vertical dimensions of the horizontal storage cell array (Figures 1-4, 6-8, and 18A-18D).

Office Action, dated July 18, 2003. Applicant respectfully disagrees. Once again, the applied reference fails to teach or fairly suggest providing a storage library comprising a **plurality of horizontal storage cell arrays**, as recited in claim 1. Dang is an example of vertical tape storage. Dang states:

The receptacle modules and the picker modules are arranged alternately side by side in a closed loop planar array. Each receptacle module has a plurality of open-ended receptacles arranged one above the other in a column which extends perpendicular to the planar array.

Dang, Abstract. Therefore, Dang teaches a planar array of vertical receptacle modules, rather than a plurality of horizontal storage cell arrays, as in the claimed invention.

Furthermore, Dang fails to teach or suggest “at least one robot mechanism that moves along a horizontal storage cell array and can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges

transported from the at least one media cartridge player into cartridge storage cells," as recited in claim 1. Since the applied reference fails to teach each and every claim limitation, claim 1 is not anticipated by Dang. New claim 10 recites subject matter addressed above with respect to claim 1 and is allowable for the same reasons.

Since claims 2-9 and 11-15 depend from claims 1 and 10, the same distinctions between Dang and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-9 and 11-15 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-7 is overcome.

The Office Action rejects claims 1-7 under 35 U.S.C. § 102 as being anticipated by Luffel et al. (US Patent No. 6,222,699). This rejection is respectfully traversed.

As to claims 1-7, the Office Action states:

Luffel '699 discloses a method for expanding a storage library having media players and horizontally moving robots per claimed invention. The method comprises increasing the library in all three dimensions by increasing the width, length, and vertical dimension of the horizontal storage cell array (Figures 1-9).

Office Action, dated July 18, 2003. Applicant respectfully disagrees. Luffel teaches a modular data storage system utilizing a wireless cartridge access device. Quite simply, Luffel fails to teach or suggest providing a storage library comprising a plurality of horizontal storage cell arrays, as recited in claim 1. Luffel is an example of vertical tape storage.

Furthermore, Luffel fails to teach or suggest "at least one robot mechanism that moves along a horizontal storage cell array and can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells," as recited in claim 1. Since the applied reference fails to teach each and every claim limitation, claim 1 is not anticipated by Luffel. New claim 10 recites subject matter addressed above with respect to claim 1 and is allowable for the same reasons.

Since claims 2-9 and 11-15 depend from claims 1 and 10, the same distinctions between Tadokoro and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-9 and 11-15 recite other additional

combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-7 is overcome.

## II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claim 6 under 35 U.S.C. § 103 as being unpatentable over Tadokoro. This rejection is respectfully traversed.

As to claim 6, the Office Action states:

Tadokoro '877 discloses all elements per claimed invention as explained in paragraph 3 above. However, it is silent as to the method step of increasing the library size vertically by stacking additional storage cells.

Nevertheless, it would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have stacked additional media modules and/or storage cells on top of Tadokoro's existing module(s) because it facilitates the expansion of the library in the vertical dimension.

Office Action, dated July 18, 2003. Applicant respectfully disagrees. Since Tadokoro fails to teach or suggest a plurality of horizontal storage cell arrays, it follows that Tadokoro provides no suggestion whatsoever to stack horizontal storage cell arrays to increase the vertical height of a storage library. The prior art of record fails to teach or suggest each and every claim limitation and proffers no suggestion to cure the deficiencies of the reference.

The Office Action may not make modifications to the prior art using the claimed invention as a model for the modifications. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art has suggested the desirability of the modification." *Id.* In other words, unless some teaching exists in the prior art for the suggested modification, merely asserting that such a modification would be obvious to one of ordinary skill in the art is improper and cannot be used to meet the burden of establishing a *prima facie* case of obviousness. Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure.

Therefore, absent some teaching, suggestion, or incentive in the prior art, Tadokoro cannot be properly modified to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed modifications, the presently claimed invention can be reached only through the an impermissible use of hindsight with the benefit of applicant's invention as a model.

Therefore, the rejection of claim 6 under 35 U.S.C. § 103 is overcome.

The Office Action rejects claims 1-7 under 35 U.S.C. § 103 as being unpatentable over White et al. (US Patent No. 6,515,822). This rejection is respectfully traversed.

As to claims 1-7, the Office Action states:

White '822 discloses of an electronic media library having storage cells arranged in a horizontal plane, at least one media player, and at least one robot mechanism for moving the media. White discloses a method step of expanding the library by stacking additional horizontal storage cell modules on top of existing module(s). However, White silent the specifics of increasing the width and length of the library.

Nevertheless, it would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have attached additional media modules to the sides and back of White '822 existing stacked module(s) because it facilitates the expansion of the library in the width and length dimension.

Office Action, dated July 18, 2003. Applicant respectfully disagrees. White is an example of a vertical storage system. As such, White does not teach or fairly suggest providing a storage library comprising a **plurality of horizontal storage cell arrays**, as recited in claim 1. In fact, White teaches away from the present invention, because White teaches only a vertical stack of storage cells, rather than a plurality of horizontal storage cell arrays, as in the present invention.

Furthermore, White fails to teach or suggest "at least one robot mechanism that moves along a horizontal storage cell array and can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells," as recited in claim 1. Since the applied reference fails to teach each and every claim limitation, claim 1 is not rendered obvious by White.

Since White fails to teach or suggest a plurality of horizontal storage cell arrays, it follows that White provides no suggestion whatsoever to stack horizontal storage cell

arrays to increase the vertical height of a storage library. The prior art of record fails to teach or suggest each and every claim limitation and proffers no suggestion to cure the deficiencies of the reference. New claim 10 recites subject matter addressed above with respect to claim 1 and is allowable for the same reasons.

Since claims 2-9 and 11-15 depend from claims 1 and 10, the same distinctions between White and the invention recited in claims 1 and 10 apply for these claims. Additionally, claims 2-9 and 11-15 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-7 is overcome.

Therefore, the rejection of claims 1-7 under 35 U.S.C. § 103 has been overcome.

### III. Conclusion

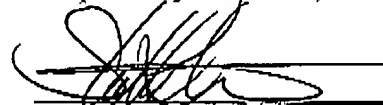
It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE:

*October 20, 2003*

Respectfully submitted,



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